

Application No. 10/795,830
Amendment After Final dated April 13, 2009
Reply to Office Action dated December 11, 2008

REMARKS

Applicants respectfully submit, contemporaneously herewith, a Request for Continued Examination pursuant to 37 C.F.R. § 1.114.

Claims 2-4, 8-19, 21-23, 25, and 26 are pending. Claims 22 and 26 have been withdrawn. Claims 11-14 are objected to. Claims 2-4, 8-10, 15-19, 21, 23, and 25 have been rejected.

Claim Rejections – 35 U.S.C. § 112

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner objects to the use of the phrase "and/or" in Claim 2. Responsive to the Examiner's objection, Applicants have deleted the phrase "and/or" and replaced the same with the phrase "and".

In view of the foregoing amendment, Applicants respectfully request removal of the Examiner's rejection of Claim 2 under 35 U.S.C. § 112, second paragraph.

Claim Rejections – 35 U.S.C. § 102(b)

Claims 2-4, 8, 15, 16, 18, 19, 21, and 25 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,904,691 to Barnett et al. ("Barnett '691").

Barnett '691 discloses surgical guide 2, shown in Fig. 1, including infrared emitters 4a-4d, aperture 106, and cylindrical boss 104. Cylindrical boss 104 is used to attach surgical guide 2 to an instrument holder. Additionally, aperture 106 is a guide aperture that supports a surgical tool and extends orthogonally with respect to the top and bottom surfaces of surgical guide 2.

Applicants respectfully submit that Independent Claim 15 is not anticipated by Barnett '691, as Barnett '691 fails to disclose each and every limitation of Independent Claim 15. Specifically, Independent Claim 15 calls for a surgical system for use during an orthopaedic surgical procedure, the system including a surgical navigation system including means for tracking the position of an object during a surgical procedure, a navigated orthopaedic guide including *means for being tracked by the surgical navigation system* and *means for establishing a datum in a desired position relative to the surgical site* and a surgical component including *means for engaging the datum positioned by the orthopaedic guide*.

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In forming the rejection, the Examiner relies on a biopsy guide, which Barnett '691 indicates may be advanced through aperture 106, as being the means for being tracked by the surgical navigation system. However, a biopsy guide, or any other surgical instrument identified by Barnett '691, fails to perform the function of being tracked by a surgical navigation system to guide the position of an orthopaedic guide into a desired position relative to the surgical site, as called for in Independent Claim 15. The only portion of the device of Barnett '691 that is capable of being tracked by a surgical navigation system are emitters 4a-4d. As the device of Barnett '691 is being moved, the system of Barnett '691 relies on the location of emitters 4a-4d, not the location of a biopsy guide, for determining the location of the orthopaedic guide. Thus, emitters 4a-4d perform the function of being tracked by the surgical navigation system.

Taking emitters 4a-4d to be the means for being tracked by the surgical navigation system, Independent Claim 15 also requires that the navigated orthopaedic guide includes means for establishing a datum at a desired position relative to a surgical site. Nowhere does Barnett '691 disclose means for establishing a datum at a desired position relative to a surgical site.

Moreover, assuming *arguendo*, that a biopsy guide or other surgical tool that may be inserted through guide aperture 106 could perform the function of establishing a datum at a desired position relative to a surgical site, Barnett '691 fails to disclose a surgical component including means for engaging the datum positioned by the orthopaedic guide to locate a surgical component at a desired position relative to a surgical site, as called for in Claim 15. Nowhere does Barnett '691 disclose engaging the biopsy guide or other surgical component that may be inserted through aperture 106 with an additional surgical component to locate the surgical component at a desired position relative to a surgical site. In fact, each of the devices that may be inserted through guide aperture 106 of Barnett '691 is intended to be removed with the removal of surgical guide 2.

For at least the foregoing reasons, Applicants respectfully submit that Independent Claim 15, as well as Claims 2-4, 8, 16, 18, 19, 21, and 25, which depend therefrom, are not anticipated by Barnett '691.

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Claim Rejections – 35 U.S.C. § 103(a)

Claims 9, 10, 17, and 21 are rejected as being obvious over Barnett '691 in view of additional references.

In forming the rejection of Claims 9, 10, 17, and 21, the Examiner relies upon Barnett '691 as disclosing or suggesting each and every limitation called for in Independent Claim 15, from which Claims 9, 10, 17, and 21 depend. However, for at least the reasons set forth above with respect to Independent Claim 15, Barnett '691 fails to disclose or suggest each and every limitation of Independent Claim 15. The Examiner's citation of additional references fails to overcome this deficiency, as none of Barnett '691 or any of the additional cited references, either alone or in combination, disclose or suggest each of the limitations of Independent Claim 15.

For at least the foregoing reasons, Applicants respectfully submit that Claims 9, 10, 17, and 21 which depend from Independent Claim 15, are not obvious over Barnett '691 in view of the additional cited references.

Allowable Subject Matter

Applicants respectfully thank the Examiner for indicating the allowability of Claims 11-14.

Conclusion

It is believed that the above represents a complete response to the Office Action and reconsideration is requested. Specifically, Applicants respectfully submit that the application is in condition for allowance and respectfully request allowance thereof.

In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition therefor and authorize that any charges be made to Deposit Account No. 02-0385, Baker & Daniels LLP.

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Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 260-424-8000.

Respectfully submitted,



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Signature

April 13, 2009

Date